

REMARKS

The Office Action has been carefully reviewed. Claims 1-21 are pending. Claims 1-21 have been amended. No new matter has been included by these amendments. Claim 1 has been amended to include the limitations of claim 2 as it appeared before the present amendment. Support for the amendment to claim 2 can be found in the specification as originally filed at least at paragraphs[0011], [0020], [0032], [0043] and Figs. 2, 3 and 5 of the published application, U.S. Pat. Appln. Publ. No. 2007/018552A1. The remaining amendments to claims 2-21 are stylistic in nature and/or made to comply with 37 C.F.R. § 1.75(c).

The Examiner states that certified copies of applications filed in Germany on 09 August 2003 ((DE) 103 37 023.4) and 30 June 2004 ((DE) 10 2004 031 682.1) on which Applicants based their claim for priority under 35 U.S.C. § 119 have not been filed. *See* Office Action at ¶ 1. Claims 6-21 are objected to under 37 C.F.R. § 1.75(c) as allegedly being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim and have not been considered on the merits. *See* Office Action at ¶ 3. Claims 1-5 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over U.S. Patent No. 5,407,243 to Reimann ("Reimann") in view of U.S. Patent No. 5,078,729 to Eichhorn ("Eichhorn") and further in view of case law. *See* Office Action at ¶ 5. Applicants respond as follows.

I. Acceptance of the Drawings.

Applicants thank the Examiner for accepting the drawings filed on 16 August 2006. Applicants have submitted new formal drawings for Figs. 1 and 3 and request acceptance of the same.

II. Consideration of Information Disclosure Statement.

Applicants thank the Examiner for considering the references cited in the Information Disclosure Statement filed on 16 August 2006 and for making these references part of the record of this application.

III. Certified Copies of Priority Documents.

The Examiner states that certified copies of applications filed in Germany on 09 August 2003 ((DE) 103 37 023.4) and 30 June 2004 ((DE) 10 2004 031 682.1) on which Applicants based their claim for priority under 35 U.S.C. § 119 have not been filed. *See* Office Action at ¶ 1. Applicants respectfully submit that certified copies of these two documents were submitted to

the United States Patent & Trademark Office on 08 February 2006, as noted on the Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 C.F.R. 1.495. Further, Applicants respectfully submit that copies of these two documents are available on the Image File Wrapper for this application and therefore request that the Examiner reconsider and withdraw this requirement.

IV. Objections To Claims 6-21 Under 37 C.F.R. § 1.75(c).

The Examiner has objected to claims 6-21 as allegedly being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. *See* Office Action at ¶ 3. Applicants have amended claims 6-21 and respectfully request withdrawal of this objection and consideration of these claims on the merits.

V. Rejections Under 35 U.S.C. § 103.

Claims 1-5 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Reimann in view of Eichhorn and further in view of case law. *See* Office Action at ¶ 5. A *prima facie* case of obviousness can be established by showing that the following three criteria are met: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. *See* MPEP § § 2143 and 2143.03; citing *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 1981 (CCPA 1974).

Additionally, under the Examination Guidelines For Determining Obviousness Under 35 U.S.C. In View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (October 10, 2007), the Examiner may establish a *prima facie* case of obviousness by setting forth factual findings concerning the state of the art and the teachings of the applied reference(s). *See id.* at 57,527. This includes determining “the scope and content of the prior art . . .; differences between the prior art and the claims at issue . . .; and the level of ordinary skill in the pertinent art . . .” *Id.*; *see also* MPEP § 2141; quoting *Graham v. John Deere*, 383 U.S. 1 (1966). The Examiner must then “provide an explanation to support an obviousness rejection under 35 U.S.C. 103 . . . 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed.” *Id.*

For at least the following reasons, the Examiner has failed to establish a *prima facie* case of obviousness under either of these methods. Accordingly, for at least the following reasons, Applicants respectfully request withdrawal of these rejections under 35 U.S.C. § 103(a).

A. Claims 1-5.

Claims 1-5 were rejected as allegedly unpatentable under 35 U.S.C. § 103 over Riemann in view of Eichhorn and further in view of case law. *See* Office Action at ¶ 5. With respect to claim 1, the Examiner states that “Riemann discloses a device for the removal of ticks 10 comprising: a housing 12, a spreadable gripper tool 14, a spreader device 16, and presser device 58 that acts in the axial direction of the device to actuate the spreader device. Riemann further discloses a first actuation of the presser device effecting a spreading of the gripper tool by the spreading device and that a closing of the gripper tool is effected by a second actuation of the presser device. Riemann further discloses the device being rotated (Col. 4 ll. 33-45).” Office Action at ¶ 5. The Examiner states that Riemann does not disclose an essentially closed cavity . . . Eichhorn discloses an essentially closed cavity 49 for containing the tick . . . [i]t would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Riemann with the cavity of Eichhorn in order to facilitate the containment of an engorged tick as taught by Eichhorn (Col. 5 ll. 17-21).” *Id.* The Examiner further states that “Riemann further does not disclose a rotation device that is actuated by a second actuation of the presser device . . . [i]t would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Riemann by automating the rotation of the gripper tool by causing it to rotate upon actuation of the pusher since it has been held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art,” *citing In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). *Id.*

Applicant respectfully submits that Riemann in combination with Eichhorn and in view of *In re Venner* does not support a *prima facie* case of obviousness in that the combination does not disclose each and every element of the claimed invention.

Specifically, Riemann does not disclose the limitations of claim 1, as amended, of a presser device that acts in the axial direction of the device to actuate the spreader device and the rotation device of the gripper tool around the longitudinal axis of the device. Rather, in

Riemann, the only disclosure of rotation at all is in the context of the rotation of the *entire* tick removing device (element 10 in Fig. 1); there is, for example, no disclosure of rotation of just the gripping device 14. *See* col. 4, lines 33-45; Fig. 1. In contrast, the invention of claim 1 discloses a presser device that actuates *inter alia* the rotation device 18, which in turn rotates the gripper tool 12 around the longitudinal axis of the tick remover device. *See* Fig. 2, elements 12, 18; paragraph [0032]. Thus, there is no disclosure in Riemann of any manner of rotating only an element of the tick removing device, but only rotation of the entire tick removing device 10.

Applicants respectfully disagree with the Examiner's assertion that *In re Venner* supports a finding of obviousness on the grounds that "providing an automatic or manual means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art." Office Action at ¶ 5. The issue in *In re Venner* was whether use of a timer to compute the molding period for trunk pistons established patentability over prior art that disclosed computation of the molding period by a human operator to determine when to withdraw the inner core of the piston from between two side core sections during molding. *See* pp. 92, 95. The *Venner* panel held that "[a] mental process is invoked" to "compute the molding period," and "the timer is set accordingly." *Id.*

In contrast, actuation of the presser device to rotate the rotation device 18 as claimed in claim 1 is not simply replacement of an automated means to replace manual means as found in Riemann; according to the Examiner's assertion, the rotation device 18 would allow for automation of the rotation of the *entire* tick remover 10. That, however, is not what is claimed in claim 1. Rather, claim 1 claims rotation of the rotation device 18 by actuation of the presser device to rotate the gripper tool 12 around the longitudinal axis of the tick remover 10, *not* the rotation of the *entire* tick remover 10. This mode of operation of the invention of claim 1 is advantageous over devices such as that in Riemann because it allows, for example, the tick remover 10 to be used on "'difficult' parts of the body, such as the armpit" where manual rotation of the *entire* tick remover device 10 would be hard to achieve. Paragraph [0023].

This is not the situation where, as in *In re Venner*, an automated device performs the function of, and thus replaces, a manual means. If that were the case, then rotation device 18 would cause rotation of the *entire* tick remover 10. But that is not the claimed function of rotation device 18 in claim 1; rather, rotation device 18 of claim 1 actuates the gripper tool 12 to

be rotated around the longitudinal axis of the tick remover **10** *without regard to rotation of the tick remover 10 itself*. Accordingly, Applicants respectfully submit that Riemann in view of Eichhorn and further in view of *In re Venner* does not establish a *prima facie* case of obviousness and requests that rejection of claims 1-5 be withdrawn.

With respect to claim 2, as amended, Riemann does not disclose that the gripper tool is detachably connected to the rotation device. Rather, in Riemann, the tick removing device comprises “a sleeve 12 having a gripping device 14 extending therethrough . . .” Col. 2, lines 61-63; *see also* col. 3, line 10 (“Extending through sleeve 12 is gripping device 14.”); col. 4, lines 46-48. During operation of the Riemann device, depression of the actuator button 16 causes the gripping device 14 to “move[] forwardly through sleeve 12.” Col. 4, lines 5-12; *see also* col. 5, lines 11-20. Thus, the gripping device 14 of Riemann extends through the entire sleeve 12 and is not connected to a rotation device (which element is completely absent in Riemann).

In contrast, the device of claim 2 comprises a housing, a spreadable gripper tool, a spreader device for the spreading of the gripper tool and a rotation device for the rotation of the gripper tool around the axis of the device. *See* paragraph [0011]. The gripper tool is detachably connected to the rotation device. *See* paragraph [0043]. The gripper tool of claim 2 can thus be detached and discarded to “eliminate risk of infection,” and also can be replaced according to the size of the parasite. Paragraph [0020]. Accordingly, the gripper tool of Riemann does not meet the limitations of the invention of claim 2 that the gripper tool is detachably connected to the rotation device of the tick remover.

Eichhorn does not cure the deficiencies of Riemann. Eichhorn discloses a tick removal tool comprising “an openable clamp structure having a compression spring to hold two pivotally attached clamping jaws normally closed at one end.” Col. 1, lines 50-54. However, Eichhorn does not disclose the limitation of claim 1 of a rotation device that rotates the gripper tool around the longitudinal axis of the tick remover upon actuation without regard to rotation of the entire tick removal tool, or the limitation of claim 2 of a gripper tool that is detachably connected to a rotation device. Accordingly, the combination of Riemann and Eichhorn does not support a *prima facie* case of obviousness and Applicants respectfully request that this rejection be

withdrawn. Further, since claims 2-4 depend from claim 1, the rejection of these claims should be similarly withdrawn.

B. Claims 6-21.

Claims 6-21 were objected to under 37 C.F.R. 1.75(c). Applicants have amended claims 6-21. Since claims 6-21 are dependent from claim 1, Applicants respectfully submit that these claims are not obvious over Riemann in view of Eichhorn and further in view of *In re Venner* for the reasons previously stated for claims 1-5.

C. The Examiner has not set forth a case for obviousness under the new Examination Guidelines.

The Examiner has also not set forth a case of obviousness of claims 1-5 under the new Examination Guidelines as set forth at 72 Fed. Reg. 57,526 (October 10, 2007). The new Guidelines state that some rationale must be set forth that outlines the reasoning why an invention is obvious. *See id.* at 57,528 (III). Suggested but non-inclusive rationales are described including:

1. Combining prior art elements according to known methods to yield predictable results;
2. Simple substitution of one known element for another to obtain predictable results;
3. Use of known techniques to improve similar devices (methods, or products) in the same way;
4. Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
5. "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
6. Known work in one field of endeavor that may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and
7. Some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicants have already addressed the last rationale listed above and respectfully submit that the Examiner has not set forth any of the other rationales (or any other rationales either) to support a finding of obviousness.

U.S. Patent Appln. Ser. No. 10/567,632
Amendment and Response to Office Action dated January 22, 2008
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CONCLUSION

Applicants respectfully submit that claims 1-21 are in condition for allowance and request allowance of the same.

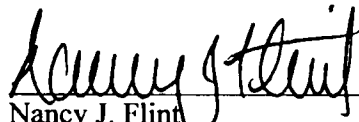
This Amendment and Response has been filed within four months of the mailing date of the Office Action and the Commissioner is authorized to deduct a fee of \$60.00 for a one month extension of time from the undersigned's Deposit Account No. 03-0683. If any variance is determined from this amount, the Commissioner is hereby authorized to deduct or credit such fees from or to the undersigned's Deposit Account No. 03-0683.

Respectfully submitted,

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